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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,989	11/18/2003	Stephane Bedard	TJK/432	4888

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SEYFARTH SHAW LLP  
131 S. DEARBORN ST., SUITE2400  
CHICAGO, IL 60603-5803

EXAMINER
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MATTHEWS, WILLIAM H

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/715,989

Applicant(s)

BEDARD ET AL.

Examiner

William H. Matthews (Howie)

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6 and 16-37 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,16-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 25-37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3,6,16-21, drawn to prosthetic foot, classified in class 623, subclass 55.
  - II. Claims 25-37, drawn to prosthetic foot system, classified in class 623, subclass 53.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require side by side sensors or connector mounted to the top part of the elongated body via the pair of sensors. The subcombination has separate utility such as for use as a testing device for measuring forces during gait cycle.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all

Art Unit: 3738

the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Furthermore, claims 20,22-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the telephonic conversation with Tim Keefer on 12-8-04. Claim 20 is described in paragraph [0051] and shown in non-elected species Figure 12. Claims 22-24 are not readable on the elected species as Figure 10 only disclose load cells.

### ***Response to Arguments***

4. Applicant's arguments filed 1-22-07 have been fully considered but they are not persuasive. With regard to Christensen, Applicant contends the pivot disclosed by Christensen is not readable on amended claim 1, specifically "the connector is mounted

Art Unit: 3738

to the top part of the elongated body via the pair of sensors". Examiner disagrees because figures 9-9b of Christensen show sensors as a portion of the adaptor 250 that connects the connector to the top part of elongated body. Furthermore, as best understood by the present Application's specification, it is unclear what is meant by "via the pair of sensors" as the specification paragraph [0043] only disclose the sensors located "under" the connector 91 (note the typo, as "91" should read "81").

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3,6,16-19,21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "the connector is mounted to the top part of the elongated body via the pair of sensors". Figures 10-11 show sensors, or load cells 22A/22B, disposed between the top part and connector, but also appear to show the sensors/plates of figures 5-6. Therefore, the specification fails to disclose the limitation of connector mounted to elongated body via a pair of sensors. In addition, Figure 11 appears to show a connecting aperture similar to those shown in Figure 6, which would allow for another part (not disclosed) to connect the elongated

Art Unit: 3738

body and connector independent of the sensors, which appear to be only positioned therebetween.

In addition, Claim 19 recites the sensors being "biased" while the specification only supports "slightly biased".

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3,6,18,19,21 are rejected under 35 U.S.C. 102(e) as being anticipated by Christensen US PUB 2003/012353.

Christensen discloses in figure 9 and paragraphs 53-58 an instrumented prosthetic foot comprising connector 250, elongated body 200 having top and bottom parts, ground engaging areas for heel 246 and toe 238, and a pair of side by side sensors or load cells 254 interfaced with a controller.

Note, the limitation "connector is mounted to the top part of the elongated body via the pair of sensors" of claim 1 is not clearly described in the specification to define what constitutes "*mounted via*". As best understood, the Christensen prosthetic foot such a mount.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen US PUB 2003/0120353 as applied to claim 1 above, and further in view of Tarjan et al. US PN 6,091,977.

Christensen meets the structural limitations of claims 16 and 17 but lack the express written disclosure of using a wired or wireless interface to connect the sensor and controller. Tarjan et al. teach control systems for prosthetic parts having sensors wherein the interface may be made by wireless or wired interfaces (c1:10-15 and c5:57-c6:44) in order to transmit data to the controller.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the prosthesis disclosed by Christensen to include a wireless or wired interface as taught by Tarjan et al. in order to transmit data to the controller.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number

Art Unit: 3738

is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H Matthews  
January 24, 2007